

Notice of Allowability	Application No.	Applicant(s)	
	10/684,991	BAXTER ET AL.	
	Examiner	Art Unit	
	Robert Shiao	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 08/08, 2005.
2. ☒ The allowed claim(s) is/are 1-23.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>04/06/04</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This application claims benefit of the provisional application:
60/418,457 with a filing date 10/15/2002.
2. Amendment of claims 1-2, 5, and 19 in the amendment filed on August 08, 2005, is acknowledged. Claims 1-30 are pending in the application.

Responses to Election/Restriction

3. Applicant's election with traverse of Group I claims 1-23, in part, in the reply filed on August 08, 2005, is acknowledged. The traversal is on the grounds that restriction of the Markush group of compounds of formula (I) is not deemed to be proper since the compounds of formula (I) containing the Markush group all share a common utility. This is found not persuasive, and the reasons are given, *infra*.

Status of the Claims

4. Claims 1-30 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 1-23, in part, drawn to compositions of formula (I), wherein the variable n and m are as defined in claim 1; the heteroaryl of variable Ar represents pyridinyl, quinolinyl, or isoquinolinyl thereof; the variable R₁, R₂, R₄, or Z independently does not represent heteroaryl or heterocycle thereof; the variable R₁, R₂, R₄, or Z independently is not substituted with heteroaryl or heterocycle.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups (i.e., heteroaryl or heterocycle of the variable Ar) which differ from those of the elected invention such as morpholine, furanyl, thiophene, etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e., class 544 subclass 106(+) (morpholine), class 549 subclass 200(+) (furanyl), class 549 subclass 1(+) (thiophene), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly.

The Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Claims 1-23, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1-23, in part, not embraced in above elected

subject matter, and claims 24-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

EXAMINER'S AMENDMENT

5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with John W. Harbour on September 19, 2005. The application has been amended as follows:

Delete claims **24-30**

Reasons for Allowance

6. The following is an examiner's statement of reasons for allowance:

Claim 1-23 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to benzyl substituted (piperidin-4-yl) aminobenzamido derivatives. The closest reference is Bigge et al. US 6,130,234, discloses 4-substituted piperidine analogs and their use as subtype selective NMDA receptor antagonists. The difference between Bigge et al. and instant claims is that the instant compounds of formula (I) are not found in Bigge et al. Suggestion for

modification of above record to obtain the instant claimed compounds/compositions, has not been found. Claims 1-23 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusions


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707.

The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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